

REMARKS

Claims 1-14 were pending in this application.

Claims 1-14 have been rejected.

Claims 11 and 14 have been amended as shown above.

Claims 15-20 have been added.

Claims 1-20 are now pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,793,361 to Kahn et al. ("*Kahn*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Kahn recites a pointing interface for a display-based computer system. (*Abstract*). The system includes multiple display screens and hand-manipulated pointers that allow control of the various screens. (*Abstract; Figure 1*). Detectors (either in or associated with the pointers) detect

“emanations” from the display screens and use that information to determine where users are aiming the pointers within the screens. (*Col. 5, Lines 1-30*). Also, the pointers emit “beams of electromagnetic radiation,” which allow other detectors in the system to identify the screens at which each pointer is aimed. (*Col. 5, Lines 31-54*).

Kahn simply recites that a first type of detector detects “emanations” from the display screens and that a second type of detector detects “beams of electromagnetic radiation” from the pointers. The first type of detector identifies the location within a screen where a pointer is being aimed. The second type of detector identifies the screen at which the pointer is being aimed. By combining this information, the system may identify the location in a specific display screen where a pointer is being aimed.

This clearly establishes that *Kahn* does not use “window identification information” in a “parameter control command” from a “remote control” to select one of multiple windows. Instead, *Kahn* simply identifies the display targeted by a pointer by detecting a radiation beam from the pointer. Nothing in these portions of *Kahn* recites that a window is selected based on information in a “command” transmitted over the beam. As a result, *Kahn* fails to anticipate selecting one of “at least two windows” in a “display device” in response to a “parameter control command” from a “remote control,” where the command includes “window identification information” as recited in Claim 1.

The Office Action notes that RF and IF remotes “can send ... commands via actuation of a key/button/selection. Thus, *Kahn* clearly selects a window based on information within the beam,

since the beam is used to select the window and also to select the appropriate action performed within the window.” (*Office Action, Page 3, First paragraph*).

First, the Office Action appears to confuse using the radiation beam of *Kahn* to select a display screen and using information transmitted over the beam to identify a location within the display screen. Only the radiation beam of *Kahn* is used to select a display screen. Information transmitted over the beam is used by the system to identify a location within the screen where the pointer is aimed. (*Col. 5, Lines 20-26 and 58-65*). However, *Kahn* contains no mention that information transmitted over the beam is used to select a window. It is clear that *Kahn* uses the contents of the radiation beam to identify a location within a display screen, not to select a display screen.

Second, the Office Action appears to assert that *Kahn* inherently uses information within a radiation beam from a pointer to select one of multiple windows. To establish inherency, the burden is on the Patent Office to present evidence clearly showing that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (*MPEP § 2112*). However, the fact that a “certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (*MPEP § 2112*). The Patent Office must “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows” from the teachings of cited reference. (*MPEP § 2112*).

The Office Action fails to show that *Kahn* must operate by selecting one of “at least two

windows” in response to a “parameter control command” that includes “window identification information” from a “remote control” as recited in Claim 1. In fact, the Office Action cannot make this showing. Once again, *Kahn* clearly recites that a display screen is selected by detecting a radiation beam, without using the contents of the radiation beam. Because of this, the Office Action cannot establish that *Kahn* inherently selects a window using “window identification information” in a “parameter control command” from a “remote control” as recited in Claim 1.

Third, to the extent that the Office Action relies on knowledge that is “well-known in the art,” the Applicant respectfully notes that this is improper under 35 U.S.C. § 102. If the Office Action relies on knowledge that is “well-known in the art,” the burden is on the Patent Office to show that a person skilled in the art would be motivated to modify *Kahn* with that knowledge and meet the other requirements of 35 U.S.C. § 103.

Fourth, the statement in the Office Action that remotes “can send ... commands via actuation of a key/button/selection” still does not render Claim 1 anticipated or obvious. Claim 1 specifically recites that one of multiple windows is selected “in response to a parameter control command” that includes “window identification information.” The Patent Office must establish that the “remotes” (either the pointers of *Kahn* or other units) cited by the Office Action are capable of communicating a “parameter control command” that includes “window identification information.” The Office Action fails to establish that the pointers of *Kahn* or other “well-known” remotes include this functionality.

For these reasons, the Office Action fails to show that *Kahn* anticipates the Applicant’s

invention as recited in Claim 1 (and its dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1-7.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 8, 9, and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over *Kahn* in view of Applicant Admitted Prior Art (“AAPA”). The Office Action rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Kahn* and AAPA in further view of U.S. Patent No. 6,204,884 to Lee (“*Lee*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

As described above in Section I, *Kahn* fails to disclose, teach, or suggest selecting a window in a "display screen" in response to a "parameter control command" received from a "remote control" that is associated with the selected window. The Office Action cites *AAPA* merely as reciting the "use of multiple displays/windows within a display screen." (*Office Action*, Page 8, Last paragraph). As a result, the Office Action fails to show that the proposed *Kahn-AAPA* combination discloses, teaches, or suggests all elements of Claims 8, 11, and 14.

For these reasons, the Office Action fails to show that the proposed *Kahn-AAPA* combination discloses, teaches, or suggests the Applicant's invention as recited in Claims 8, 11, and 14 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 8-14.

III. NEW CLAIMS

The Applicant has added new Claims 15-20. The Applicant respectfully submits that no new matter has been added. The Applicant respectfully requests entry and full allowance of Claims 15-20.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that all pending claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fee) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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